REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS & AMENDMENTS

In items 4 and 6 on page 1 of the Office Action, claims 28-34 were incorrectly listed as pending and rejected. Instead, claims 7, 20, 21, 33, 39, 40 and 42 are pending and rejected as acknowledged in the enablement rejection on page 2.

Claims 21, 33, 39 and 40 are amended to further limit the definitions of R^1, X, Y and A as supported by the claims as filed and page 28, line 19 to page 29, line 16 and page 35, lines 4-17 of the disclosure.

New claims 43-46 further limit the definition of X as supported at page 35, lines 10-11.

Therefore, no new matter has been added by this amendment.

Claims 7, 20, 21, 33, 39, 40 and 42-46 are pending upon entry of this amendment.

II. FOREIGN PRIORITY

Kindly acknowledge the claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f), as well as receipt of the verified copies of the foreign priority document.

III. INFORMATION DISCLOSURE STATEMENT

Attached to the Office Action were Examiner-initialed PTO-1449 Forms listing the references cited in the IDS's of February 19, 2002, April 16, 2002 and February 22, 2005.

However, the references in the IDS of February 19, 2002 were not initialed. Nor was US 5,750,134 in the IDS of February 22, 2005. Thus, kindly consider these references and return an Examiner-initialed copy of the appropriate Forms PTO 1449 indicating such.

III. ENABLEMENT REJECTION

On pages 2-3, claims 7, 20, 21, 33, 39, 40 and 42 were newly rejected under 35 U.S.C. § 112, first paragraph, on the basis that the specification is enabled for "compound A" of the Examples, but not for all other compounds of the claimed formulae given the breadth of R^1, X and A.

This rejection is respectfully traversed as applied to the amended and new claims.

The test of enablement is whether one reasonably skilled in the art could make or use the invention based on the disclosure in the specification coupled with the knowledge in the art without undue experimentation. The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. The test is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. See M.P.E.P. § 2164.01.

On page 2 of the Office Action, it was indicated that the rejection was made on the basis of the breadth of R^1, X and A in the formulae of the claims. Moreover, it was suggested that the claimed compounds be amended to compounds which are "closely related to instant experimental compound A" in relation to size, polarity and electronegativity.

It is respectfully submitted that the present amendment amends the claims as suggested by the Examiner to compounds which are "closely related" to the compound indicated as enabled (i.e., compound A). Again, as noted above, claims 21, 33 and 39-40 are amended to further limit the definitions of R^1, X, Y and A. By doing so, the compounds of the amended claims are closely related to compound A. At page 81, lines 10-12, the specification demonstrates the effectiveness of compound A. It is respectfully submitted that this working example is representative of the compounds of the amended claims.

Furthermore, on pages 13-17 of the specification, numerous other compounds are disclosed with melatonin receptor agonist activity. These structures should provide sufficient enablement for skilled artisans to make other melatonin receptor agonists based on the structures in amended claims 21, 33, 39 and 40 and new claims 43-46.

Thus, it is respectfully submitted that one of skill in the art would be able to make and use the compounds of the amended and new claims without undue experimentation given the guidance in the specification and the working example.

Lastly, it is respectfully submitted that claims 7 and 20 should not have been included in the rejection, because these claims are limited to compound A and do not recite a formula having R^1, X and A. In other words, these claims are limited to that which is indicated as enabled by the Office.

In view of the above, the enablement rejection of claims 7, 20, 21, 33, 39, 40 and 42 under 35 U.S.C. § 112, first paragraph, is untenable and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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